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UNITED STATES COPYRIGHT CLAIMS BOARD

DAVID G. OPPENHEIMER,  
Claimant,

vs.

DOUGLAS A. PRUTTON,  
Respondent.

Claim No. 22-CCB-0045

**CLAIMANT'S REPLY TO PARTY  
STATEMENT OF RESPONDENT  
DOUGLAS A. PRUTTON**

**1. Preliminary Objections: Groundless Name Calling and Violations of FRE 408**

Rather, most of the Respondent's Statement is devoted to name calling and seeking to cast aspersions on Claimant, on his attorney (the party typically held responsible for the bad faith tactics that define a "copyright troll"), and perhaps on Congress itself for enacting the Copyright Act that, without reservations, causes infringers like Respondent to be held accountable. Respondent also accuses Claimant of seeking redress of copyright violations in bad faith, yet Respondent, who is an attorney, is the one abusing the prohibition against putting into evidence his version of settlement discussions under Rule 408 of the Federal Rules of Evidence.

Claimant objects to the irrelevant, inflammatory, and unsubstantiated allegations that Claimant is a copyright troll. Claimant started working as a photographer in 1998, and traveled extensively around the United States working as a photographer creating and selling photographs. For over 10 years he worked as a photographer before he became aware of any infringements of his many works, and only then began to register the copyrights of his works out of necessity. See Reply Declaration of Oppenheimer. Respondent admits that he was invited to

1 settle the case before suit was filed. The fact that Claimant has never had to go to trial obviously  
2 suggests that he works to find means to settle with infringers.

3 In this case, Claimant agrees that his counsel invited Respondent to move the case to the  
4 Copyright Claims Board<sup>1</sup> as a means to resolve the dispute, assuring Respondent, honestly and  
5 correctly, that he would no longer face claims of DMCA violations or payment of attorney's  
6 fees. To support the "copyright troll" narrative, Respondent would have been the one who would  
7 have reasonably suggested moving the case to the CCB, which then would have been followed  
8 by a sneering rejection of the idea by Claimant and a request for increased attorneys' fees for  
9 which Claimant would seek to hold Respondent liable due to the clear liability. That didn't  
10 happen, but it has not prevented Respondent from casting a shadow on the invitation to resolve  
11 the claim before the CCB, vaguely suggesting that Claimant had some sinister intent.

12 If, on the other hand, Respondent is correct that a copyright troll is a holder of an  
13 infringed copyright who seeks compensation to which the holder is entitled prior to having to file  
14 suit but, due to the volume of copyrights under the holder's charge, holder has had to file many  
15 previous suits against infringers who refuse to engage in good faith settlement negotiations, then  
16 there are many examples of copyright trolls by this definition, including the likes of BMI and  
17 ASCAP. Sometimes such infringers express in writing that their insurer will not address a claim  
18 until after a complaint is filed, or Claimant encounters or re-encounters willful, deliberate, and/or  
19 repeat infringers.

20 In other words, such frequent plaintiffs in such instances are doing exactly what Congress  
21 empowered them to do to vindicate their copyrights, regardless of what names they are called.  
22 Respondent strains to suggest abusive litigation tactics have been employed, but the evidence is  
23 nonexistent.

24 In short, there is nothing wrong with seeking redress for copyright infringement as has  
25 been clearly authorized and encouraged by Congress in enacting the Copyright Act. That attitude

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26  
27 <sup>1</sup> The constructive invitation had nothing to do with Respondent's completely invalid service of a subpoena  
28 on Claimant's litigation counsel (not Claimant) in California. Claimant lives in a district 3000 miles away in North  
Carolina. Unlike in California state court, where there are statutory provisions for requesting outside of discovery  
that documents be produced at trial, there is no federal equivalent. A subpoena is a discovery tool. By court  
scheduling order, the discovery deadline had long passed by the time the invalid subpoena was initiated.

1 is, at least in part, the upshot of the holding in *Strike 3 Holdings v. Doe*, 964 F.3d 1203, 1208  
2 (D.C.C.A. 2020), a case coming from the prestigious District of Columbia Court of Appeals and  
3 that urges trial courts (and in this case the CCB) to not become distracted by rank  
4 characterizations. Rather, they should adhere to what Congress laid out in the Copyright Act.

5 In a similar vein, revealing the real practitioner of bad-faith tactics, Respondent has also  
6 given his self-serving recital of some of the settlement discussions between the parties. Since he  
7 is an attorney, he knows but has refused to heed the prohibition under Rule 408 of the Federal  
8 Rules of Evidence against offering evidence of settlement communications.

## 9 **2. Liability and Damages Are Essentially Uncontested**

10 Although Respondent is a lawyer, trained to follow and advise others in following the  
11 law, he offers no legally-recognized excuse for using the subject photograph on his website. To  
12 his credit, he does not say that he believed he could use the Photograph on his website without  
13 permission. Copyright law is quite clear that someone owns the rights to the Photograph (it not  
14 being a photograph that he could in good faith believe was so old or created by a government  
15 employee that it must be in the public domain). Respondent's claim that he didn't know that  
16 Oppenheimer was the copyright owner is no defense to the claim that he did not seek permission  
17 from whomever is the owner of the copyright.

18 In fact, the evidence presented by Oppenheimer is that he consistently provides copyright  
19 notice and other copyright management information. There is no evidence that something  
20 different was done in this case. Respondent produced no evidence on where on the Internet the  
21 image was copied, nor is there any evidence whatsoever offered seeking to rebut Oppenheimer's  
22 evidence that whatever Respondent found gave clear copyright notice. Without evidence of the  
23 native file copied from the Internet or similar verification of the source of the Photograph, it is  
24 not probative to consider an iteration of the Photograph, with no provenance, that ended up in  
25 Respondent's GoDaddy account.

26 By the same token, it is in no way probative for Respondent in a copyright case to offer  
27 no evidence of what Respondent actually did do, but instead self-servingly state that he or she  
28 "would not" (the conditional tense, factually speculative by definition) have removed the

1 watermark or cropped the image. The only evidence (not fluff “would have” statements) is that  
2 the watermark always appeared on wherever Oppenheimer displayed it on the Internet.

3 Respondent also states that he conducted a search that showed the Photograph on the  
4 Internet without copyright management information. He does not say when he conducted the  
5 search, but it appears to have been done in response to this claim, perhaps years after he copied  
6 and commenced displaying on his website to promote his law practice. See Exhibit D to  
7 Respondent’s Declaration. The thumbnail images shown on Exhibit D are indeed from a Google  
8 search (Google performing an archival or library-search function that under law is fair use).  
9 Concerning the thumb image in the upper right that appears to be Claimant’s photograph of the  
10 Oakland federal building, Respondent does not say what happened when he clicked on the image  
11 which, as invited, which should have brought him to the page where the photograph was found  
12 and where copyright and/or licensing information could have been found.

13 If, on the other hand, the click-through by Respondent brought him to a page not  
14 authorized by Claimant, it’s doubtful that any such evidence would be probative, even if  
15 reflecting availability of the photograph back when it was first copied by Respondent; there’s  
16 still no evidence of where it was copied by Respondent or why he, a lawyer, thought that  
17 whoever owned the Photograph gave him permission. But since the search was conducted much  
18 later, there is no conceivable relevance.

19 Respondent also cites a case brought by Oppenheimer where he filed a motion for  
20 summary adjudication to establish there was no issue of fact concerning the defense of fair use.  
21 Since it was a motion for summary adjudication, the burden was on Oppenheimer to establish  
22 that there was no issue of fact concerning the fair use defense. At trial, the burden is on  
23 defendant to prove fair use. This claim before the Board is in the same posture as a trial; the  
24 burden is on Respondent to prove fair use if he can. He offers no proof.

25 Nor is there any proof of unclean hands/misuse of copyright. Respondent cites the case of  
26 *Harrington v. 360 ABQ, LLC*, 2022 WL 1567094 (DC NM 2022) as an example. One of the  
27 bases for characterizing the defendant there as a copyright troll seeking to entrap infringers was  
28 the allegation that:

1           • Mr. Harrington has allowed for years his photographs to be available  
2           on websites without a copyright or ownership notice;

3           • Mr. Harrington intends for his photographs to be available on certain  
4           websites without copyright notice to induce innocent users to download  
5           and use his photographs. *Id.* at \*1.

6       These copyright practices are the exact opposite of the evidence presented by Oppenheimer, and  
7       they are not practices alleged by Respondent. More to the point, the defense – whether under the  
8       guise of “copyright misuse” or “unclean hands” for the same practice of copyright enforcement –  
9       has no application here. By way of example, the Ninth Circuit Model Jury Instructions, No.  
10      17.24 “Copyright—Affirmative Defense—Copyright Misuse,” provides this overview of the law  
11      of copyright misuse:

12           The Ninth Circuit explicitly adopted copyright misuse as a defense to  
13           copyright infringement in *Practice Management Information Corp. v.*  
14           *American Medical Association*, 121 F.3d 516, 520 (9th Cir. 1997),  
15           *amended by* 133 F.3d 1140 (9th Cir. 1998). “The copyright misuse  
16           doctrine prevents holders of copyrights ‘from leveraging their limited  
17           monopoly to allow them control of areas outside the monopoly.’” *Oracle*  
18           *USA, Inc. v. Rimini St.*, 879 F.3d 948 (9th Cir. 2018) (quoting *Apple Inc. v.*  
19           *Psystar Corp.*, 658 F.3d 1150, 1157 (9th Cir. 2011)), *rev’d on other*  
20           *grounds*, 139 S. Ct. 873 (2019). Copyright misuse is an equitable defense  
21           to copyright infringement. *Vernor v. Autodesk, Inc.*, 621 F.3d 1102, 1115  
22           (9th Cir. 2010). It does not apply when there is no allegation of copyright  
23           infringement. *Altera Corp. v. Clear Logic, Inc.*, 424 F.3d 1079, 1090 (9th  
24           Cir. 2005). Copyright misuse precludes enforcement of a copyright during  
25           the period of misuse, but it does not invalidate the copyright. *Practice*  
26           *Mgmt.*, 121 F.3d at 520 n.9.

27           Although it must be said it is flattering to align Claimant, an individual and small-  
28           business professional photographer, with the likes of Oracle, Apple, and other huge corporations  
29           able to manipulate markets with the sheer power of their copyright-based technologies, it is  
30           absurd to suggest that this ordinary copyright infringement case presents analogous  
31           circumstances, or that one aerial photograph of the federal building in Oakland would possess  
32           the same brute force on the photography market as the technology was alleged to have in the  
33           above cases. The defense is absurd, argued in bad faith, designed to harass, and is completely  
34           inapplicable.

35           Additionally, Respondent’s allegations are not at the pleading stage of a case. Again, this  
36           matter is at the trial stage. Respondent has submitted no evidence to establish copyright misuse

1 or unclean hands, having at most only briefly referred to hearsay evidence, consisting of what a  
2 court “said was said” in the course of a pre-trial deposition.

3 Finally, concerning the award of damages sought in this case<sup>2</sup>, statutory damages are  
4 intended to compensate a claimant. Respondent, an attorney, trained to marshal evidence, offers  
5 no evidence to rebut the actual damages claimed in this case (\$5500 for a 2-year license).

6 But also and as a primary purpose in a case like this, statutory damages are intended to punish  
7 and deter Respondent for unexcused infringement. Without a sufficient penalty, whether the  
8 infringement was not willful, or it was willful (the latter compelling a greater sum), without  
9 deterrence Respondent would have no incentive in the future to either not infringe or seek a  
10 license. Tellingly, Respondent, especially with his unapologetic condescension and blame of  
11 Claimant for exercising his rights (and implicitly his disdain for any tribunal that would award  
12 adequate and lawful damages to him), does not offer any legally recognized excuse for his  
13 infringement or any reason to believe he would not behave the same if he had it to do all over  
14 again.

### 15 3. Conclusion

16 For all the foregoing reasons, Claimant David Oppenheimer respectfully requests an  
17 award in his favor as more fully explained and described in Claimant’s Party Statement.

18  
19  
20 Dated: January 31, 2023

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21 s/Lawrence G. Townsend

22 Lawrence G. Townsend

23 Attorney for Claimant

24 DAVID G. OPPENHEIMER

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26  
27 <sup>2</sup> It goes without saying that Respondent has fallen far short of carrying his burden of proving innocent  
28 infringement under Section 504(c)(2) that would justify a statutory damage award between \$200 and \$750. He has  
never even tried to show evidence that he had reason to believe in good faith that he had permission to use the  
Photograph from the copyright holder nor anyone else.